

**REMARKS and SUMMARY OF TELEPHONE INTERVIEW**

The claims are 1-3, 5-8, 9-13, and 15-24. Claim 24 is newly presented; other claims are amended as indicated above. Withdrawal of the rejections and reconsideration of the application are respectfully requested.

**Remarks re Section-112 Rejections – Claims 2 and 15**

The rejections of claims 2 and 15 are rendered moot by the amendments to claim 2 and claim 13 (the parent claim of claim 15).

**Remarks re Section-112 Rejections – Claims 11 and 12**

The rejections of claims 11 and 12 are respectfully traversed and their withdrawal is requested. The Federal Circuit approved a claim in the same basic format in its 1994 *Warmerdam* case. See *In re Warmerdam*, 33 F.3d 1354, 31 USPQ2d 1754 (Fed. Cir. 1994) (reversing indefiniteness rejection).

Claim 5 of the *Warmerdam* application read as follows:

5. A machine having a memory which contains data representing a bubble hierarchy generated by the method of any of Claims 1 through 4.

*Id.*, 33 F.3d at 1358. The Federal Circuit reversed an indefiniteness rejection, noting that “[t]he legal standard for definiteness is whether a claim reasonably apprises those of skill in the art of its scope.” *Id.* at 1361 (citations omitted). The court observed that “[t]here is no requirement that a claim for a machine which incorporates process steps, such as claim 5, must conform to the conventional definition of a product-by-process claim,” and held that “[t]here has been no showing that one skilled in the art would have any particular difficulty in determining whether a machine having a memory containing data representing a bubble hierarchy is or is not within the scope of claim 5.” *Id.*

Here, likewise, there has been no showing that anyone skilled in the art would have any particular difficulty in determining whether a program storage device is or is not within the scope of claims 11 or 12. Such a determination should be quite straightforward and easy to make in many cases — if the software stored in the program storage device can perform the operations recited in the corresponding method claims, then the program storage device infringes claim 11 or 12 as appropriate.

Claims such as claims 11 and 12 are also “a good thing” on policy grounds because they promote judicial economy. Such claims can be asserted against a vendor of “infringing” software as a direct infringer without the need for the patent owner to prove the extra elements required for active inducement of infringement or contributory infringement. Such claims therefore help conserve resources, both for litigants and for the judicial system.

The rejections of claims 11 and 12 on indefiniteness grounds therefore should be withdrawn.

**Remarks re Section-102 Rejections over Chiang '725; Summary of Telephone Interview**

The Examiner's courtesy in the telephone interview of December 16, 1999, is acknowledged with appreciation. During the interview, the Examiner, co-inventor Scott Hutchinson, and the undersigned attorney had a detailed discussion of the teachings of the Chiang et al. patent, U.S. Patent No. 5,835,725, as well as those of other references cited in the Office action, and compared those teachings with the language of the claims of the present application. The remarks below summarize the discussion with particular attention to Chiang '725.

Chiang '725 is directed to "[a]n address resolution protocol technique [to] enable[ ] an intermediate station of a heterogeneous network to dynamically assign an address to an end station for use in a communication session between the end station and other stations of the network." Chiang '725 at Abstract (emphasis added); *see also id.* at column 7, lines 49-54. In Chiang '725 a client node (referred to there as a "workstation") "initiates the session by issuing a novel address assignment request to the router. In response to the request, the router assigns the workstation an address chosen from a pool of addresses allocated to the router." *Id.* at column 7, lines 63-67. The transmission of a MAC address by the Chiang '725 client node / workstation occurs in a `cap_xchange` message if the workstation has already had a MAC address assigned to it. *See id.* at column 8 lines 43-49, 59-62, column 9 lines 21-44.

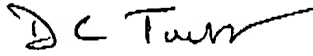
In the present claims, on the other hand, the general approach of the claims is for the client node and the server node to use both the current NIC address value (corresponding to the previously-assigned MAC address in Chiang '725) and the former NIC address value as a two-part unique identifier for the client node, for purposes such as transmitting and/or storing asset-management information in a data record. It is submitted that such an approach is neither taught nor suggested in Chiang '725 nor in the other cited references.

A formal agreement on allowability of the claims was not reached during the telephone interview. The general consensus of the discussion was that the claims likely would distinguish over the cited references if they were amended to recite (i) the use of the NIC address as the node identifier value, and (ii) the transmission (or, in the case of the server-oriented claims the reception) of asset-management information together with current and former NIC address values. The Examiner indicated that he wanted to see the actual amended claims in writing, and possibly to perform an additional search, before determining allowability. All claims have been amended or newly presented to include claim elements along the lines referred to above.

*(Continued on next page)*

All claims are believed to be in condition for allowance; early passage to issuance is requested.

Respectfully submitted,



D. C. Toedt III  
Reg. No. 31,144  
713-561-4001  
[dtoedt@bindview.com](mailto:dtoedt@bindview.com)

ATTORNEY FOR ASSIGNEE

BINDVIEW DEVELOPMENT CORPORATION  
5151 San Felipe, Suite 2100  
Houston, Texas 77056  
713-561-1001 (FAX)

Date: February 14, 2000